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In the Supreme Court of the United States

OCTOBER TERM, 1980

FEIST PUBLICATIONS, INC., PETITIONER

v.

RURAL TELEPHONE SERVICE COMPANY, INC., RESPONDENT

**On Writ of Certiorari to the
United States Court of Appeals
for the Tenth Circuit**

**BRIEF OF AMERITECH, BELL ATLANTIC,
NYNEX CORPORATION, PACIFIC TELESIS GROUP,
AND SOUTHWESTERN BELL CORPORATION
AS AMICI CURIAE IN SUPPORT OF RESPONDENT**

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QUESTION PRESENTED

Whether copyright in a "white pages" telephone directory protects the copyright owner against wholesale use of the directory's listings in the preparation of a competing directory.

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BRIEF OF AMERITECH, BELL ATLANTIC,
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AS *AMICI CURIAE* IN SUPPORT OF RESPONDENT

INTEREST OF THE *AMICI CURIAE*

Amici Ameritech, Bell Atlantic, NYNEX Corporation, Pacific Telesis Group, and Southwestern Bell Corporation are companies that, directly or through subsidiaries, publish and register with the Copyright Office telephone "white pages" directories. Petitioner's contentions here call into question the scope of the copyright protection available in such directories. *Amici* therefore submit this brief to assist the Court in the resolution of this case.¹

¹ The parties' letters of consent pursuant to Rule 37 of the Rules of this Court have been filed with the Clerk of the Court.

SUMMARY OF ARGUMENT

Two propositions are central to the arguments of petitioner and all of its *amici*: the assertion that the court of appeals permitted respondent to copyright "facts," and the related contention that copyright in a directory precludes only the verbatim reproduction of the directory's precise selection of data in an identical arrangement. In our view, neither proposition has merit.

1. Individual facts as such, of course, are not subject to copyright. But respondent has not sought to assert control over the republication of particular facts. Instead, respondent's copyrightable (and therefore protectible) contribution was its compilation of a coordinated mass of information into a useful and coherent whole. The authorship here accordingly inheres in the aggregation and unified presentation of the interrelated data selected for inclusion in the directory. That respondent seeks to protect this contribution rather than facts as such is clear from the nature of its complaint: it objects not to petitioner's use of particular facts but to the wholesale appropriation of the contents of its directory. The language of 17 U.S.C. §§ 101 and 103(a), which protects compilations of data "as a whole," confirms that respondent's contribution is protected.

In arguing to the contrary, petitioner and its *amici* reason that the Copyright Act of 1976, 17 U.S.C. §§ 101 *et seq.*, precludes republication only of a directory's precise selection of data in an identical arrangement. That argument, however, reads the word "coordinated" out of the statute. And even on its own terms, the argument is insupportable. In no other setting may someone who copies copyrighted material evade an infringement claim by omitting or rearranging some of that material. Nor does petitioner gain anything from its repeated invocation of Section 103(b). That provision—if relevant here at all—simply confirms the undisputed point that particular facts are not subject to copyright. It is not ad-

dressed to the question whether the contributions of a compiler in presenting a coordinated collection of data may be protected.

2. The propriety of respondent's reading of the Copyright Act is confirmed by the legislative background. Prior to enactment of the 1976 Act, the courts uniformly had held that wholesale appropriation of data from a directory was improper, even when the second directory modified the selection of data or presented it in different form. There was no confusion on that point; so far as we are aware, every court to consider the issue prior to 1976—including this one—had reached that conclusion. And when it enacted the 1976 Act, Congress expressly endorsed the pre-1976 decisions on originality and the scope of copyright protections. That should be dispositive here.

3. With this said, it bears emphasis that petitioner's approach would entirely remove copyright protection from many of the most valuable reference works. Many forms of arrangement used by such works—those that are alphabetical, numerical, and so on—are not themselves original. If a directory that uses such an arrangement is comprehensive (so that the selection of data is not, under petitioner's theory, a matter of judgment), petitioner would allow a competitor simply to reproduce and sell copies of the original compilation. Indeed, petitioner's approach would permit the wholesale appropriation of any directory's contents so long as some additional data is included (as in this case) or the format is varied slightly. The resulting "new" directory then could be sold at a fraction of the original compiler's cost. The outcome of such a scheme is predictable: there will be a reduced incentive to create directories and other compilations. It seems manifest that such an outcome could not have been the intent of Congress, which enacted the Copyright Act to provide incentives for the creation and dissemination of useful works.

Of course, it may well be, as several of petitioner's *amici* suggest, that portions of directories (and other works) might appropriately be used for noncompetitive purposes without infringing the owner's copyright. In our view, however, this observation points up the wisdom of the approach taken by the court below. The fact-specific inquiry suggested by these *amici* expressly comes into play under Section 107 of the Act, which permits fair use of concededly copyrightable works. Cases like this one therefore may be most satisfactorily resolved by recognizing the existence of copyright and asserting the propriety of copying on a case-by-case basis in a fair use inquiry. Here, the courts below engaged in that inquiry and correctly concluded that petitioner's use of the material taken from respondent's directory in the preparation of a competing publication was not fair.

ARGUMENT

THE COPYRIGHT ACT OF 1976 PRECLUDES THE WHOLESALE COPYING OF THE CONTENTS OF A DIRECTORY

In effect, petitioner contends that the compiler of a directory like the telephone "white pages," despite its central role in the creation of the compilation, is entitled to no copyright protection in the resulting work. Indeed, petitioner and its *amici* argue in so many words that the *entire* contents of *every* factual compilation may be copied so long as the copier adds to (or subtracts from), or rearranges, a portion of the original compilation's data. This understanding of the Copyright Act of 1976 (the "Act" or "Copyright Act"), 17 U.S.C. §§ 101 *et seq.*, would work a radical change in the law of copyright—and would create a powerful disincentive to the production of directories and similar compilations.

In demonstrating the flaws in petitioner's argument, respondent sets out in some detail the language and history of the Act establishing that directories are subject

to copyright (Resp. Br. 11-18); that the courts prior to enactment of the Act had precluded the wholesale copying of data from compilations (Resp. Br. 25-28); and that Congress meant to endorse the decisions of those courts when it passed the Act. See Resp. Br. 28-31. We do not view these propositions as subject to serious dispute, and petitioner does not even attempt to contest the latter two points. Further discussion of these issues here accordingly is unnecessary.

Instead, we will address two propositions that are central to the arguments of petitioner and all of its *amici*: the assertion that the court of appeals permitted respondent to copyright "facts," and the related contention that copyright in a directory (if available at all) precludes only the verbatim reproduction of the directory's precise selection of data in an identical arrangement. In our view, these propositions misapprehend both the basis of the holding below and the reach of the Copyright Act.

A. Respondent's Copyright Protects Its Compilation As A Whole Rather Than Individual Facts

1. It is common ground between the parties that facts, as such, are not subject to copyright. See Section 102 (b); *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 548, 556 (1985). Seizing on this, petitioner and its *amici* assert that, because each individual white pages listing reports a set of facts, the holding below permits respondent to assert monopoly control over the data presented in its directory. But this is a significant misstatement of respondent's position. Respondent does not seek to prevent republication of particular facts. It does not contend that it may prevent others from compiling and publishing an identical directory through their independent efforts. Nor, for that matter, does it seek copyright protection for its labor or research as such—although it bears emphasis that petitioner did, in fact, appropriate the fruits of respondent's industry.

Instead, respondent's original—and therefore copyrightable—contribution was its compilation of a coordinated mass of related data into a useful and coherent whole. The authorship here inheres, not in the facts themselves (and not in the placing of one alphabetically arranged listing in front of another), but in the unified presentation of the interrelated data selected for inclusion in the directory. As Professor Denicola put it, "[t]he particular collection of data [is] itself . . . a work of authorship." Denicola, *Copyright in Collections of Facts: A Theory for the Protection of Nonfiction Literary Works*, 81 Colum. L. Rev. 516, 530 (1981) (emphasis in original). That respondent seeks to protect this contribution rather than facts as such is clear from the nature of its complaint: it objects not to petitioner's use of particular facts but to the wholesale appropriation of the contents of its directory—an appropriation that necessarily takes the elements of original authorship contributed by respondent.

The language of the Copyright Act makes clear that these elements are protected. Section 103(a) provides that compilations are subject to copyright. The term compilation in turn is defined in Section 101 as "a work formed by [1] the collection and assembling of preexisting materials or of data [2] that are selected, coordinated, or arranged [3] in such a way that the resulting work as a whole constitutes an original work of authorship." Respondent surely "collect[ed]" and "assembl[ed]" the data in its directory. It is equally clear that respondent "selected" the data to be included and presented it as a "coordinated" whole. And since the directory plainly has the requisite originality to warrant a copyright, see Resp. Br. 9-10, the resulting work must be protected "as a whole." Wholesale copying of the directory's contents accordingly is proscribed by the Act.

This understanding—that the Act permits the copying of particular facts but precludes wholesale appropriation of data from a directory—is hardly novel. To the con-

trary, it was shared by the National Commission on New Technological Uses of Copyrighted Works ("CONTU"), which offered perhaps the most authoritative contemporaneous analysis of the Act's scope.² Specifically analogizing data bases to telephone directories, CONTU explained that

[t]he use of one item retrieved from such a work—be it an address, a chemical formula or a citation to an article—would not under reasonable circumstances merit the attention of the copyright proprietor. Nor would it conceivably constitute infringement of copyright. The retrieval and reduplication of any substantial portion of a data base, whether or not the individual data are in the public domain, would likely constitute a duplication of the copyrighted element of the data base and would be infringement.

CONTU Final Report 103 (1978).

2. Petitioner and its amici, of course, offer a different reading of the statutory language. They do not seriously contest the proposition that respondent "collect[ed] and assembl[ed]" data within the meaning of Section 101. And some of petitioner's amici, at least, acknowledge that the compilation as a whole is "an original work of authorship." See Haines and Co., Inc. ("Haines") Br. 7; Int'l Ass'n of Cross Reference Directory Publishers ("IACRDP") Br. 10-11; Third-Class Mail Ass'n ("TCMA") Br. 5. Their argument thus turns on the second prong of the statutory definition of "compilation"

² CONTU was established by Congress in 1974—prior to enactment of the Act—to propose legislation addressing the copyright issues presented by computers and photocopiers. Its recommendations were enacted by Congress in 1980 as an amendment to the Act. Computer Software Copyright Act of 1980, Pub. L. No. 96-517, 94 Stat. 3015. Its views accordingly have been regarded as authoritative. See *Whelan Associates, Inc. v. Jaslow Dental Laboratory, Inc.*, 797 F.2d 1222, 1241 (3d Cir. 1986), cert. denied, 479 U.S. 1031 (1987); *Apple Computer, Inc. v. Franklin Computer Corp.*, 714 F.2d 1240, 1252 (3d Cir. 1983), cert. dismissed, 464 U.S. 1033 (1984).

and the terms "selected, coordinated, or arranged." In particular, petitioner and its amici reason that the Copyright Act precludes republication only of a directory's precise selection of data in an identical arrangement. See Pet. Br. 22; Ass'n of North American Directory Publishers, *et al.* ("ANADP") Br. 17-18; Direct Marketing Ass'n ("DMA") Br. 17; IACRDP Br. 14-15.

This argument, however, rests on an incomplete and misleading reading of the Act. For one thing, it reads the term "coordinated" out of the statute; while not defined in the Act, the term (particularly in contrast to its disjunctive statutory siblings "selected" and "arranged") suggests the grouping of related data together into a useful whole—precisely the contribution that respondent seeks to protect here. And even on its own terms, petitioner's argument is peculiar. In every other setting, someone who copies copyrighted material cannot evade an infringement claim by omitting some of the material (or by including the material in a larger work); in Judge Learned Hand's famous phrase, "no plagiarist can excuse the wrong by showing how much of his work he did not pirate." *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 56 (2d Cir.), cert. denied, 298 U.S. 669 (1936). See *Harper & Row*, 471 U.S. at 565. It is not clear why a different result should apply when the bulk, but not all, of the listings selected by the original author for inclusion in a copyrighted directory are copied. In such circumstances, the person who copies the listings has appropriated the copyright owner's "select[ion]" of materials, a contribution that petitioner and its amici acknowledge is protected.

Petitioner's principal response on this point, as we understand it, is its assertion that there has been no meaningful selection of data here because respondent's white pages are all-inclusive. Pet. Br. 18. As respondent explains, however (Br. 18), a significant number of choices go into the creation of a white pages directory; the similar directories produced by petitioner's

amici themselves illustrate that more or less data (such as zip codes, neighborhood designations, and the like) may be included in such compilations. See Haines Br. 2; IACRDP Br. 5. In any event, petitioner evidently means to contend that the more inclusive—and therefore the more useful—a directory, the less the protection to which it is entitled under the Copyright Act. Such a rule would be worse than nonsensical; it would encourage compilers to omit data from their directories so as to qualify for copyright protection. It is impossible to believe that Congress meant to create such a system.

In addition, petitioner's proposed "selection and arrangement" test is simply unmanageable as a practical matter. While the arrangement of telephone white pages is largely routinized, respondent makes clear (Br. 18) that the compiler necessarily must make a range of choices: whether to include middle names or initials; whether to list honorifics; whether to separate out residential, business, and government listings; when to close the annual directory; and so on. If the second directory copies the data from the first, it inevitably will copy those choices as well. Filtering out each choice, and determining which had been appropriated by someone who copied the directory, would be extraordinarily difficult. And again, in the presence of wholesale copying of the directory's contents, it is hard to imagine that the availability of copyright protection was meant to turn on this sort of inquiry.

3. In arguing to the contrary, petitioner and its amici gain nothing by their repeated invocation of Section 103 (b), which provides that "[t]he copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material." Petitioner asserts that the individual white pages listings are "preexisting material" within the

meaning of Section 103(b). Even if this is so, however, it is beside the point here. As we note above, respondent is not attempting to exercise monopoly control over those materials as such; it seeks to protect only its original contribution—its presentation of a coordinated collection of related data. Nothing in Section 103(b) is inconsistent with that claim.

In any event, it is doubtful that Section 103(b) was directed at compilations of fact at all. Section 101 of the Act provides that “compilations” may be composed of “preexisting materials or of data” (emphasis added). The directory at issue here plainly is a compilation of the latter sort. But Section 103(b) is directed only at compilations and derivative works composed of “preexisting material”; it makes no mention of “data.” While not defined in the Act, such preexisting materials apparently are those—unlike data—of the sort that might be subject to copyright.³ Congress presumably meant something when it drew this distinction and directed Section 103(b) exclusively at “preexisting material.”

In fact, the reason for the distinction is clear from Section 103(b)’s legislative history. In proposing the statutory revision that ultimately led to enactment of Section 103(b), the Register of Copyrights had a particular purpose in mind: establishing that copyright in a new version of an already copyrighted work (or of a work that had fallen into the public domain)—that is, “preexisting material”—is available only if the new elements would themselves support a copyright. Similarly,

³ “Collective works” are examples of compilations that are made up of preexisting material. Collective works are defined in Section 101 to include such things as anthologies, “in which a number of contributions, constituting separate and independent works in themselves, are assembled into a collective whole.” Section 101 specifically provides that “[t]he term ‘compilation’ includes collective works.”

he also wanted to confirm that a new copyright of this sort would not give its owner control over the preexisting work. Referring to Section 7 of the Copyright Act of 1909, ch. 320, 35 Stat. 1075, 1077, the Register accordingly explained that “[w]hat the present statute fails to make clear is the basic requirement that the new elements must in themselves represent original creative authorship.” *Copyright Law Revision: Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law*, 87th Cong., 1st Sess. 9 (Comm. Print 1961).⁴

Expanding on this, the Chief of the Register’s Examining Division stated that, “[u]nder the [1909] statute, as the [Register’s] Report points out, it is unclear that the elements added to the work must, in order to support a new copyright, represent ‘original, creative authorship’ in themselves. The *only* recommendation that the Report made on this point was simply that this requirement be made clear in the statute.” *Copyright Law Revision, Pt. 2: Discussion and Comments on Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law (“Discussion and Comments”)*, 88th Cong., 1st Sess. 65 (Comm. Print 1963) (remarks of Ms. Ringer) (emphasis added). Put another way, the Register’s proposal was directed to the question “how much revision is necessary to support a new copyright in what’s known, loosely, as a ‘new version.’” *Id.* (remarks of Ms. Ringer). Not surprisingly, then, none of the comments on or discussion of the Register’s proposal touched on compilations of fact. See *id.* at 13 (remarks of Mr. Robinson and Mr. Kaminstein); *id.* at 65-88; *id.*

⁴ The Register thus sought to make clear that, for example, one could not obtain a copyright simply by republishing without change a version of “Hamlet” that had fallen into the public domain; similarly, he wanted to establish that copyright in a “new” version of “Hamlet” (with, for example, new marginal notes) would extend only to the new material and not to the underlying play.

at 303 (remarks of Mr. Henn); *id.* at 372 (remarks of Mr. Nimmer).⁶

Congress endorsed this purpose when it enacted Section 103(b). The Register's proposal was adopted without significant modification. See generally I A. Latman & J. Lightstone, *The Kaminstein Legislative History Project: A Compendium and Analytical Index Leading to the Copyright Act of 1976*, at 62-81 (1981). Congress accordingly explained that Section 103(b) was "intended to define, more sharply and clearly than does section 7 of [the 1909 Act], the important interrelationship and correlation between protection of preexisting and of 'new' material in a particular work. The most important point here is one that is commonly misunderstood today: copyright in a 'new version' covers only the material added by the later author, and has no effect one way or the other on the copyright or public domain status of the preexisting material." H.R. Rep. No. 1476, 94th Cong., 2d Sess. 57 (1976). See S. Rep. No. 473, 94th Cong., 1st Sess. 55 (1975).

Indeed, the very structure of Section 103(b) suggests that the statute is directed at new versions of existing works rather than original compilations of data. The provision mandates that copyright in a compilation or derivative work "extends only to the material contributed by the author of such work." While it is not defined in

⁶ That Section 103(b) was directed at this problem is confirmed by consideration of its antecedents. The provision was designed to "clarify the language of * * * section 7 of the [1909] statute." *Discussion and Comments* at 62 (remarks of Ms. Ringer). That provision was not addressed to compilations of data; it concerned the copyrightability of "compilations or abridgements, adaptations, arrangements, dramatizations, translations, or other versions of works in the public domain, or of copyrighted works." 35 Stat. 1075, 1077 (emphasis added). Enactment of Section 103(b) accordingly must have been prompted by concerns about the treatment of compilations or derivative works based upon existing works.

the Act, the term "material" suggests the written matter that makes up a work. Yet compilations of pure fact, which this Court already has indicated are subject to copyright (see *Harper & Row*, 471 U.S. at 547), may contain no textual materials contributed by the author that individually are copyrightable. Indeed, petitioner concedes that copyright extends to the compiler's selection and arrangement of listings—contributions that do not add "material" within the ordinary meaning of that term. It thus seems plain that Section 103(b) was not directed at the problem at issue in this case.

In saying this, of course, we do not mean to suggest that copyright in a compilation of data extends to the facts that are reported in the individual listings. But granted that facts are not subject to copyright, Section 103(b) simply was not addressed to the question whether the contributions of a compiler in presenting a coordinated collection of data may be protected. Respondent contends for no more in this case.

B. The Background Of The Act Confirms That Wholesale Appropriation Of Data From A Directory Is Improper

Although many of the relevant statutory terms are not defined in the Copyright Act, respondent's reading of the statute is confirmed by the legislative background. As respondent explains (Br. 25-28), prior to enactment of the Act the courts uniformly had held that wholesale appropriation of data from a directory was improper, even where the second directory somewhat modified the selection of data or presented it in a different format. There was no confusion on this point; so far as we are aware, every court to consider the issue prior to 1976 had reached that conclusion. And the issue had arisen with some frequency: it had been decided by the First, Second, Sixth, Seventh, and Ninth Circuits, as well as by district courts in the Fifth and Eighth Circuits. See *Sampson & Murdock Co. v. Seaver-Radford Co.*, 140 F. 539 (1st Cir. 1905); *Jeweler's Circular Publishing Co.*

v. *Keystone Publishing Co.*, 281 F. 83 (2d Cir.), cert. denied, 259 U.S. 581 (1922); *W.H. Anderson Co. v. Baldwin Law Publishing Co.*, 27 F.2d 82 (6th Cir. 1928); *Schroeder v. William Morrow & Co.*, 566 F.2d 3 (7th Cir. 1977); *Adventures in Good Eating, Inc. v. Best Places to Eat, Inc.*, 131 F.2d 809 (7th Cir. 1942); *Leon v. Pacific Tel. & Tel. Co.*, 91 F.2d 484 (9th Cir. 1937); *Southwestern Bell Tel. Co. v. Nationwide Independent Directory Service, Inc.*, 371 F. Supp. 900 (W.D. Ark. 1974); *Southern Bell Tel. & Tel. Co. v. Donnelly*, 35 F. Supp. 425 (S.D. Fla. 1940).

Indeed, this Court reached the same conclusion shortly before the enactment of the 1909 Act, which itself was to be "declaratory of existing law." H.R. Rep. No. 2222, 60th Cong., 2d Sess. 10 (1909). In *Dun v. Lumbermen's Credit Ass'n*, 209 U.S. 20 (1908), the Court addressed an infringement claim involving competing listings of credit ratings. The Court found that the plaintiff was not entitled to enjoin publication of the second directory because the defendant had compiled most of its entries through an "elaborate and comprehensive system of obtaining independent information." *Id.* at 23 (citation omitted). But the Court understood the appropriation of some listings from the original compilation to infringe the compiler's copyright, and it therefore remitted the plaintiffs "to a court of law to recover such damage as they might there prove that they had sustained." *Id.* at 24. Almost 50 years later the Court implicitly confirmed that understanding, indicating that "a copyrighted directory is not infringed by a similar directory which is the product of independent work." *Mazer v. Stein*, 347 U.S. 201, 218 (1954) (emphasis added).

These courts did not dispense with the "originality" requirement, as petitioner and its amici complain. See, e.g., Pet. Br. 17-18. Instead, as one of the leading pre-Act decisions put it, the courts reasoned that the individual materials making up the directory need not "show

literary skill or originality." *Jeweler's Circular*, 281 F. at 88. The requisite originality of the work as a whole lay in the "industrious collection" and subsequent presentation of data (*id.*); as the same court explained, the compiler "produces by his labor a meritorious composition, in which he may obtain a copyright, and thus obtain the exclusive right of multiplying copies of his work." *Id.* See *Schroeder*, 566 F.2d at 5; *Leon*, 91 F.2d at 486. And the copyright in this "meritorious composition" was understood to preclude wholesale appropriation of the directory's coordinated collection of data. If this were not so, the courts explained, "there would be practically no copyright in such a work as a directory." *Jeweler's Circular*, 281 F. at 89 (citation omitted).

Petitioner and its amici do not suggest that their position is reconcilable with this authority. Instead, they evidently are of the view that all of the pre-1976 rulings are inconsistent with the 1976 Act. See, e.g., ANADP Br. 18-19 & n.21. In fact, however, Congress explained the Act in terms almost identical to those used in decisions such as *Jeweler's Circular* and *Leon*. It made clear that copyright is available in a compilation "regardless of whether the individual items in the material have been or ever could have been subject to copyright." H.R. Rep. No. 1476, *supra*, at 57; S. Rep. No. 473, *supra*, at 55. And so far as the work as a whole is concerned, Congress declared that the requisite originality "does not include requirements of novelty, ingenuity, or esthetic merit." H.R. Rep. No. 1476, *supra*, at 51; S. Rep. No. 473, *supra*, at 50. Indeed, for more than a century it has been clear that a work satisfies the originality requirement so long as it has been created independently by its author. See *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 58 (1884). Cf. *Harper & Row*, 471 U.S. at 547 ("Creation of a nonfiction work . . . entails originality") (emphasis added). Almost by definition, that requirement is satisfied by the "industrious collection" that goes into the production of an original directory.

In any event, as respondent explains (Br. 13-17, 28-31), both Houses of Congress expressly endorsed the pre-1976 decisions on originality and the scope of copyright protections at the time the Act was enacted. Petitioner and most of its amici entirely fail even to address the import of this history. The single exception is the brief of amici Ass'n of North American Directory Publishers, *et al.*, which suggests (Br. 10 & n.9) that the development of Section 103(b) demonstrates dissatisfaction with the pre-Act decisions. As we explain above, however, Section 103(b) was directed at an entirely different problem; nowhere in its history is there a word of disapproval—nor, for that matter, mention of any sort—of decisions involving directories or other compilations of fact. Even if Section 103(b) is applicable here, then, it could not have been a response to decisions like *Jeweler's Circular* and *Leon*. Congress therefore must be understood to have endorsed the unbroken line of decisions precluding the wholesale appropriation of the contents of directories.

C. Petitioner's Approach Would Largely Eliminate Copyright Protection in Compilations Of Fact

1. With all of this said, the focus on the Act's language and history should not obscure the practicalities here. Petitioner's "selection and arrangement" approach evidently would prevent the verbatim reproduction of directories, like the telephone "yellow pages," that have a variable format.* But that approach would entirely remove copyright protection from many of the most valuable reference works. The most useful forms of arrange-

* When yellow pages are compiled, employees of the publisher, in consultation with individual businesses, typically make a discretionary determination of the headings under which the businesses are listed; they also determine whether a business warrants listing in several geographic directories. In addition, the yellow pages headings themselves are variable from directory to directory. See generally *Southwestern Bell Media, Inc. v. Trans Western Publishing, Inc.*, 670 F. Supp. 899, 907 (D. Kan. 1987).

ment—those that are alphabetical, numerical, geographical, chronological, and so on—are not themselves original; "two always comes after one, and no one can copyright the mere sequence of Arabic numbers." *West Publishing Co. v. Mead Data Central, Inc.*, 799 F.2d 1219, 1227 (8th Cir. 1986), cert. denied, 479 U.S. 1070 (1987). If a directory that uses such an arrangement is comprehensive (so that the selection of data is not, under petitioner's theory, a matter of judgment), petitioner seemingly would allow a competitor simply to photocopy and sell copies of the original compilation. Indeed, petitioner candidly acknowledges the scope of its theory in arguing that compilations like the telephone white pages are not subject to copyright at all. Pet. Br. 15-18.

Even apart from verbatim reproduction, petitioner's approach would permit the wholesale appropriation of any directory's contents so long as some additional data is included (as in this case) or the format is varied slightly. Given modern technology, this sort of repackaging of data—data that the author might have spent months or years compiling—literally could be accomplished in minutes; the original directory's listings could be fed into a computer (optical scanners would spare the copier the necessity even of entering the data by hand), and the computer could be instructed to rearrange the data automatically. See CONTU Final Report 103-104; Note, *Copyrighted Compilations of Facts in a Public Domain Directory: The Criteria of Infringement*, 71 Nw. U.L. Rev. 833, 841 (1977). Indeed, petitioner's approach would permit the copier to skip this middle step altogether by the simple expedient of appropriating the material already in a computer data base, which cannot meaningfully be said to have an arrangement at all. See Denicola, *supra*, 81 Colum. L. Rev. at 531. In either case, the resulting "new" directory could profitably be sold at a fraction of the original compiler's cost.

The outcome of such a regime is predictable: practically no one will produce directories and similar reference

works. The creation of such works often is enormously expensive and time-consuming. But petitioner would permit anyone to buy a single copy of such a work and then reproduce and sell it—or, at best, repackage the work before selling it. Indeed, the import of petitioner's argument is that Congress not only sanctioned such a system as a matter of copyright law, but also affirmatively eliminated *all* protections for authors of such works by preempting state laws that create "rights that are equivalent to any of the exclusive rights within the general scope of copyright." 17 U.S.C. § 301(a). It seems manifest that such an outcome would frustrate the central purpose of the Copyright Act and the Constitution's Copyright Clause, which specifically were intended to provide incentives for the creation of useful works. See, e.g., *Harper & Row*, 471 U.S. at 546.

We say this, of course, with the knowledge that providers of telephone service often are obligated by law to produce white pages directories. Needless to say, that is not true of the vast range of directories; yet the language of Sections 101, 102, and 103 leaves no room for the creation of rules that would accord white pages lesser protection than that available to other compilations of fact. And even when there is a legal mandate, the incentive to produce a thorough and useful directory will be affected by the ease with which its contents may be pirated. As in this case, the obligation to publish a telephone directory often is framed in very general terms that leave the publisher considerable leeway in determining the directory's contents and method of production. See Pet. Br. 1a (simply requiring telephone companies in Kansas to "issue at least annually a dated telephone directory"). And the producers of such directories surely will take less care in their compilation if the contents may be appropriated by competitors immediately upon publication.

2. Against this, petitioner asserts a single argument from the policy of the Copyright Act: that subsequent

compilers must be permitted to appropriate respondent's material "in order to promote the public's access to information." Pet. Br. 19. But whatever the force of this policy in the abstract, it never has been effectuated by permitting the wholesale copying of factual works—the result baldly contended for by petitioner here. The reason for this is plain. There will be no useful works to disseminate if the incentive to create them is destroyed; as this Court has noted, "[i]f every volume that was in the public interest could be pirated away by a competing publisher, . . . the public [soon] would have nothing worth reading." *Harper & Row*, 471 U.S. at 559 (citation omitted). In any event, as respondent explains (Br. 38-39 n.22), petitioner is not disseminating ideas or insights in any meaningful sense, and the suggestion that its commercial piracy should be encouraged as a social service is, to say the least, substantially overstated.⁷

Indeed, many of the points advanced by petitioner's amici point up the wisdom of the approach taken by the court below. Those amici argue that lesser copyright protections should be available here because the copyrighted publication is a factual work (see *Haines* Br. 13), or that lesser protections should be provided when the alleged infringer is not a competitor of the copyright holder. See IACRDP Br. 16; DMA Br. 20; TCMA Br.

⁷ Respondent declined to license use of its directory by petitioner. Pet. App. 7a. This behavior stands in stark contrast to that of amici and the rest of the industry, who make their listings available on reasonable terms. But whether or not respondent's refusal was wrongful, petitioner's remedy lay in the antitrust laws, not in the use of self-help in the form of infringement of respondent's copyright. In fact, petitioner has, thus far successfully, been pursuing antitrust relief in the lower courts. See *Rural Tel. Service Co. v. Feist Publications, Inc.*, 737 F. Supp. 610 (D. Kan. 1990), app. pending, No. 90-3254 (10th Cir. 1990). In its petition for a writ of certiorari, petitioner presented the question whether wrongful refusal to deal by a copyright holder should preclude enforcement of the copyright, Pet. i, question 2. This Court limited the grant of certiorari to exclude that question.

8. In our view, these considerations simply have no bearing on the basic scope of copyright protections. They do, however, expressly come into play under Section 107 of the Act, which permits fair use of concededly copyrighted works in defined circumstances. See generally *Harper & Row*, 471 U.S. at 560-569. Cases like this one therefore may be most satisfactorily resolved by recognizing the existence of copyright and assessing the propriety of copying in a fact-specific fair use inquiry. Here, the courts below engaged in that inquiry and concluded—correctly, as respondent demonstrates (Br. 42-50)—that petitioner's use of the material taken from respondent's directory for the purpose of preparing a competing volume was not fair.

D. The Plaintiff In An Infringement Action Need Not Prove That The Copyrighted And Infringing Works Are Substantially Similar When Copying Has Been Established

Finally, several of petitioner's amici—although not petitioner itself—assert that, if respondent's directory is entitled to copyright protections, the court below nevertheless erred in finding infringement because it failed to determine both that petitioner copied the directory and that the two directories are "substantially similar." See Haines Br. 8-13; IACRDP Br. 17-20. This argument is without merit. The asserted "substantial similarity" requirement is entirely absent from the Copyright Act, which grants the copyright owner exclusive rights "to reproduce the copyrighted work" and "to prepare derivative works based upon the copyrighted work." 17 U.S.C. § 106(1), (2). The Act goes on to make clear that "[a]nyone who violates any of the exclusive rights of the copyright owner . . . is an infringer of the copyright." 17 U.S.C. § 501(a). And those rights surely are infringed when—as concededly was true in this case (see Pet. App. 7a-8a, 11a)—the copyrighted work is used as the basis for preparation of the second work. See 17 U.S.C. § 101

(defining "derivative work" as "a work based upon one or more preexisting works").

Thus, as the late Professor Nimmer explained, "[r]educed to most fundamental terms, there are only two elements necessary to the plaintiff's case in an infringement action: ownership of the copyright by the plaintiff and copying by the defendant." 3 M. & D. Nimmer, *Nimmer on Copyright* § 13.01, at 13-14 (1990) (footnotes omitted). Substantial similarity between the works simply supports an inference of copying in the absence of direct proof. "It is generally not possible to establish copying by direct evidence Therefore copying is ordinarily established indirectly by the plaintiff's proof of access [to the copyrighted work by the defendant] and substantial similarity." *Id.* § 13.01[B], at 13-7 to 13-8 (footnotes omitted).

As a consequence, proof of copying may fail to establish infringement only when the thing copied is not *itself* copyrightable. As the Second Circuit put it,

[c]opying may be inferred where a plaintiff establishes that the defendant had access to the copyrighted work and that substantial similarities exist as to protectible material in the two works. Put another way, [the plaintiff] must show that his book was "copied," by proving access and substantial similarity between the works, and also show that his expression was "improperly appropriated," by proving that the similarities relate to copyrightable material.

Walker v. Time Life Films, Inc., 784 F.2d 44, 48 (2d Cir.) (citations omitted), cert. denied, 476 U.S. 1159 (1986). That is the distinction drawn in each of the cases cited by petitioner's amici.*

* See, e.g., *Harper House, Inc. v. Thomas Nelson, Inc.*, 889 F.2d 197, 207-208 (9th Cir. 1989); *Cooling Systems & Flexibles, Inc. v. Stuart Radiator, Inc.*, 777 F.2d 485, 491-492 (9th Cir. 1985); *Hochling v. Universal City Studios, Inc.*, 618 F.2d 972, 977 (3d

The "substantial similarity" argument therefore simply is another way of stating the principal contention of petitioner and its amici: that the contents of respondent's directory as a whole are not protected. If the Court rejects that contention, the "substantial similarity" argument must fall as well.

CONCLUSION

The judgment of the court of appeals should be affirmed.

Respectfully submitted.

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Cir.), cert. denied, 449 U.S. 841 (1980); *Sid & Marty Krofft Television Productions, Inc. v. McDonald's Corp.*, 562 F.2d 1167, 1162, 1165 (9th Cir. 1977); *Universal Athletic Sales Co. v. Salkeld*, 511 F.2d 904, 908 (3d Cir.), cert. denied, 423 U.S. 863 (1975). The portion of this Court's decision in *Teleprompter Corp. v. Columbia Broadcasting System, Inc.*, 415 U.S. 394, 398 n.2 (1974), cited by amici Haines at Br. 9, stands only for the proposition that "[u]se of copyrighted material not in conflict with a right secured by § 1 [of the 1909 Copyright Act, now 17 U.S.C. § 106], no matter how widespread, is not copyright infringement." Here, of course, petitioner's reproduction of a portion of respondent's directory (and its preparation of a derivative work based on that directory) did conflict with those exclusive rights.

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